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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,476	07/25/2001	Hideaki Miyazaki	1405.1046	3966
21171	7590	08/28/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			BOVEJA, NAMRATA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/911,476

Applicant(s)

MIYAZAKI ET AL.

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/25/01</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-24 were elected by the applicant in response to the restriction notice sent on 05/05/2006 and are presented for examination.

### *Objections*

2. Applicant is required to submit a list of the original claims with (Cancelled) written next to the claim number for each claim the applicant is canceling and (Original) written next to the claims he is claiming in the original format. See 37 CFR 1.121. Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

3. Claim 3 is rejected under 35 U.S.C. 112 second paragraph.

Claims 3 recites the limitation "said transmitting-terminal" in line 2. There is insufficient antecedent basis for this limitation in the claim, since "said transmitting-terminal" was not cited in previous claims.

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, since the recitation "prompts on the receiving terminals selection of desired merchandise from the merchandise information table," renders the claim indefinite, because it is unclear what the Applicant means by this statement. It is interpreted to mean that the user at the

receiving terminal is prompted to select the desired merchandise from the merchandise information table. Appropriate correction is required.

5. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, since the recitation "character information for displaying," renders the claim indefinite, because it is unclear what the Applicant means by this statement. It is interpreted to mean that instructions regarding how to display information are transmitted. Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4-8, 10-12, 14, 15, and 17-24 are rejected under 102(e) as being anticipated by Walker et al. (Patent Number 6,216,111 hereinafter Walker).

In reference to claims 1, 20, and 24, Walker teaches a select-call administration method, system, and program for administrating calls pertaining to select phone calls between calling terminals and receiving terminals (abstract), the select-call administration method comprising: a step of notifying a receiving terminal that a call from a calling terminal is a select phone call (col. 8 lines 46-56); correspondence information (i.e. the length of the call) based on receiving-terminal correspondence to a call from a calling terminal (col. 6 lines 66 to col. 7 lines 4 and col. 8 lines 50-53); and a

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step of acquiring a step of creating point information (i.e. credits) based on correspondence information acquired by said correspondence information acquisition means and presenting awards (i.e. a payment to a credit card or phone bill) based on said point information (col. 2 lines 24-27 and 33-48, col. 3 lines 19-21, col. 6 lines 27-46 and 65 to col. 7 lines 4, col. 7 lines 21-31, col. 8 lines 19-27 and 50-53, and col. 9 lines 10-13).

7. In reference to claim 4, Walker teaches a select-call administration system characterized by carrying out a voice announcement that a call from a calling terminal is a select call (col. 8 lines 49-53).

8. In reference to claim 5, Walker teaches a select-call administration system wherein said select-call notification means incorporates into a messaging signal and transmits message information to the effect that a call from a calling terminal is a select phone call (col. 8 lines 49-56).

9. In reference to claims 6 and 7, Walker teaches a select-call administration system wherein based on the correspondence information said point-award presentation means adds and stores predetermined points (i.e. credits) to a point value set for a receiving terminal having received a call pertaining to a select phone call (col. 2 lines 63-65, col. 3 lines 10-14, col. 5 line 67 to col. 6 lines 6, col. 6 lines 43-46 and lines 65 to col. 7 lines 4, col. 7 lines 21-31, col. 8 lines 19-22 and 50-61, and col. 9 lines 10-13).

10. In reference to claim 8, Walker teaches a select-call administration system wherein based on point information administered by said point information administration means said point-award presentation means discounts fees charged to

the receiving terminals (col. 6 lines 66 to col. 7 lines 4, col. 7 lines 21-31, col. 8 lines 19-27 and 50-56, and col. 9 lines 10-13).

11. In reference to claim 10, Walker teaches a select-call administration system wherein based on the correspondence information said point-award presentation means adds predetermined points (i.e. credits) to a point value set for a third party (i.e. credits on the phone bill for answering questions about life insurance) apart from the calling terminals and the receiving terminals (col. 8 lines 19-27).

12. In reference to claim 11, Walker teaches a select-call administration system wherein said point-award presentation means based on the point information charges fees to a calling terminal having transmitted a call pertaining to a select phone call (i.e. the insurance company conducting the survey is charged with \$10 that it applied as a credit to the user's credit card or phone bill) (col. 6 lines 65 to col. 7 lines 4, col. 7 lines 21-23 and 27-29, and col. 8 lines 19-27 and 50-53).

13. In reference to claim 12, Walker teaches a select-call administration system wherein the correspondence information is call length of a select call (col. 6 lines 65 to col. 7 lines 4 and col. 7 lines 50-53).

14. In reference to claims 14 and 21, Walker teaches a select-call administration system further comprising point information notification means for reporting, to the calling terminal and the receiving terminal having completed a select phone call, point information created based on the call pertaining to the select call (col. 5 lines 67 to col. 6 lines 2 and col. 6 lines 43-46).

15. In reference to claim 15, Walker teaches a select-call administration system wherein said point information notification means reports the point information via voice announcement (col. 7 lines 21-31 and col. 8 lines 49-56).

16. In reference to claims 17 and 22, Walker teaches a select-call administration system further comprising: point information setting means for presetting points (i.e. credits) added to a point value for a receiving terminal when in response to a call from a calling terminal a select phone call has taken place (col. 6 lines 66 to col. 7 lines 4, col. 7 lines 21-31, and col. 8 lines 49-56); point prior-notification means for receiving terminal, during issuance of a phone call from a calling terminal, of point information set by said point information setting means (col. 7 lines 21-31, and col. 8 lines 49-56); and receive-call selection means for a receiving terminal to select in response to a phone call from a calling terminal whether or not a select phone call takes place (col. 6 lines 16-25 and 47-51 and col. 8 lines 49-56).

17. In reference to claim 18, Walker teaches a select-call administration system wherein said point information setting means accepts points-to-be-issued information issued from the calling terminals (col. 5 line 67 to col. 6 lines 2 and col. 6 lines 43-46).

18. In reference to claims 19 and 23, Walker teaches a select-call administration system wherein said receive-call selection means is provided with: receive-call condition acceptance means for accepting receive-call conditions from the receiving terminals to permit select calls on the receiving terminal end (col. 8 lines 49-56); and receive-call rejection means for comparing with the receive-call conditions points-to-be-issued

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information issued from a calling terminal and disconnecting a call from the calling terminal (col. 6 lines 47-51).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 2 and 3 are rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Voit et al (Patent Number 5,805,682 hereinafter Voit).

In reference to claim 2, Walker is silent about a select-call notification means that displays transmitting-terminal identification information on the receiving terminals. Voit teaches displaying transmitting-terminal identification information on the receiving terminals (abstract, col. 1 lines 20-25, col. 2 lines 17-25, and col. 6 lines 7-20). It would have been obvious to modify Walker to display transmitting-terminal identification information on the receiving terminals in order to give the recipient an option of knowing who is calling visually without having to pick up the phone instead of just orally by having to pick up the phone.

20. **Disclaimer:** Claim 3 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 3, Walker does not specifically disclose the transmitting-



terminal identification information to consist of a telephone number beginning with predetermined numerals established for said phone call. Voit teaches the transmitting-terminal identification information to consist of a telephone number beginning with predetermined numerals established for said phone call (abstract, col. 1 lines 20-25, col. 2 lines 17-25, and col. 6 lines 7-20). It would have been obvious to modify Walker to include in the transmitting-terminal identification information a telephone number beginning with predetermined numerals established for said phone call in order to let the recipient know the number of the calling party in addition to a description of the called party to enable the call recipient to call back the calling party at a later time if deemed necessary.

21. Claims 9, 13, and 16 are rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Official Notice.

**Disclaimer:** Claim 9 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 9, Walker is silent about a select-call administration system wherein said point-award presentation means is provided with a merchandise information table in which point information and product information are corresponded; and where the receiving terminal prompts for the selection of desired merchandise from the merchandise information table.

Official Notice is taken that it is old and well known to offer products in exchange for points and display this information in a chart format while prompting the user to

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simultaneously make a selection for the desired award as done by frequent flyer program websites. The sites display as a chart how many miles are needed to receive a free ticket, an upgrade, or free beverages on flight for example, and it lets the user make the redemption electronically for the reward in exchange for the miles. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to offer products in exchange for points and display this information in a chart format while prompting the user to simultaneously make a selection for the desired award to offer the recipient the option to redeem credits for other awards than just a monetary credit to his account.

22. In reference to claim 13, Walker is silent about a select-call administration system wherein the correspondence information is operational information pertaining to operational content in the receiving terminals.

Official Notice is taken that it is old and well known to determine operational information pertaining to operational content in the receiving terminals such the operating system on a computer in order to ensure that the file that is being sent to the user will be accessible by the user's operating system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include determining the operational information pertaining to the operational content in the receiving terminals in determining the correspondence information to ensure that the information being sent to the recipient for display will be visible to the recipient.

23. **Disclaimer:** Claim 16 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was

applied.

In reference to claim 16, Walker is silent about a select-call administration system wherein said point information notification means transmits character information (i.e. display instructions) for displaying the point information on display devices on the calling terminals and the receiving terminals.

Official Notice is taken that it is old and well known to include display instructions for displaying point information on display devices on user terminals such as done by airline rewards websites to display mileage required for a domestic flight, an international flight, an upgrade, or free beverages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include display instructions for displaying point information on display devices on user terminals to enable the users to visually see how much credit the user will be receiving for his participation in a given call.

#### ***Point of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

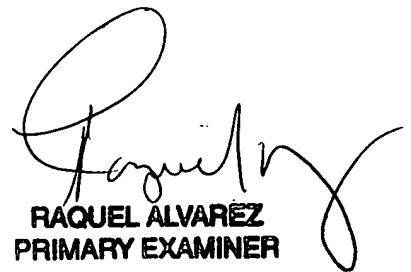
you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 1866-217-9197 (toll-free).



NB

August 21<sup>th</sup>, 2006



**RAQUEL ALVAREZ**  
**PRIMARY EXAMINER**